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10/027,696

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04/20/2006

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EXAMINER

DIXON, THOMAS A

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/027,696

Applicant(s)

VILLAPUDUA, MISSY L.

Examiner

Thomas A. Dixon

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,17,18 and 20 is/are rejected.
- 7) ☒ Claim(s) 3 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, filed 1/20/06, are not convincing. Cerra (6,546,373) teaches that the smart cards of O'Flaherty et al ('247) as credit cards (see figure 1B), therefore, the smart card of O'Flaherty et al ('247) is seen as inherently having the capability of being the payment instrument and meets the language of the claims.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-18, 20 are rejected under 35 U.S.C. 102(e) as anticipated by Walter (2002/0087472) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Walter (2002/0087472) in view of Cerra (6546,373).

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As per Claim 17.

Walter ('824) discloses a method for protecting consumer personal data, comprising:

providing the consumer with a payment instrument (smartcard) having stored thereon a privacy preference and consumer account information necessary to tie a debit or credit payment transaction to a consumer account, see smart card, credit card or loyalty card in Fig. 3 and paragraphs (0025), (0036-0038), wherein the application comprises personal data and a privacy preference of a consumer (see paragraph (0045), see Fig. 4);

reading the privacy preference from the payment instrument when making a purchase at a merchant location, wherein the consumer information is read to provide payment to a merchant, see (0036-38);

wherein the purchase request provides the consumer account information as well as the personal data and the privacy preference from the user of the payment instrument, without separate entry of the personal data and the privacy preference from an instrument other than the payment instrument, see (0036-38).

Walter does not specifically teach the smart card can be a payment instrument.

Cerra ('373) teaches smart cards can inherently be financial instruments, see figure 1B or alternately that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a smart card for a financial instrument for the benefit of increased security and functionality associated with smart cards.

As per Claims 18 and 20:

Walter (824) further discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card), see paragraphs (0025), (0036-0038).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-10 are rejected under 35 U.S.C. 103(a) as anticipated by Walter (2002/0087472) in view of O'Flaherty et al (6,275,824) or, in the alternative, under 35

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U.S.C. 103(a) as obvious over Walter (2002/0087472) in view of O'Flaherty et al (6,275,824) further in view of Cerra (6546,373).

As per Claim 1.

Walter (824) discloses a method for protecting consumer personal data, comprising:

- receiving an application for a payment instrument (e.g. smart card, credit card or loyalty card in Fig. 3 and paragraph (0025)), wherein the application comprises personal data and a privacy preference of a consumer, see paragraph (0045), see Fig. 4;

- saving the application in a database, see Figs. 1 and 5) that is associated with an issuing financial institution Who issued the payment instrument, see paragraph (0044) for the inherent financial institution, which is issuing the card;

- storing at least some of the personal data and the privacy preference onto the payment instrument, wherein the payment instrument includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account that is associated with the issuing financial institution, see paragraphs (0025), (0036)-(0038); and

- receiving a purchase request at a credit or debit processing system that is associated with a merchant financial institution, wherein the purchase request is in response to presentation of the payment instrument and the customer account information and at least some of the personal data and the privacy preference, see paragraphs (0012)-(0013), (0036)-(0038), (0040), (0044); and

- saving the privacy preference in a database associated with the merchant financial institution (28), see paragraphs (0036)-(0038),

- wherein the purchase request provides the consumer account information as well as the personal data and the privacy preference from the user of the payment instrument, without separate entry of the personal data and the privacy preference from an instrument other than the payment instrument, see (0036)-(0038).

Walter (824) does not disclose the application is received before the payment instrument is issued.

O'Flaherty et al (824) teaches entering privacy preferences at a kiosk before issuance of a card, see column 5, lines 1-9 for the benefit of expediting issuance of a card.

Walter does not specifically teach the smart card can be a payment instrument.

Cerra ('373) teaches smart cards can inherently be financial instruments, see figure 1B or alternately that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a smart card for a financial instrument for the benefit of increased security and functionality associated with smart cards.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide a kiosk to collect data for the issuance of a card for the benefit of expediting issuance of a card.

As per Claims 2 and 4:

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Walter (824) further discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card), see paragraphs (0025), (0036)-(0038).

As per Claim 5:

Walter (824) further discloses the method including the step of reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location, see paragraphs (00121)-(0013), (0036J)-(0038), (0040), (0044)).

As per Claim 6:

Walter (824) further discloses the method including the step of mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see paragraph (0003)).

As per Claims 7-8:

Walter (824) further discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants (see paragraphs (0003), (0006) by controlling the type of personal data that may be collected).

As per Claim 9:

Walter (824) further discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank (Id.).

As per Claim 10:

Walter (824) further discloses the method, wherein the privacy preference indicates that the consumer opts out (see paragraph (0008)).

#### ***Prior Art Made of Record***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Randle et al teaches governments using smart cards for benefit payments (debit cards).

Terranova teaches user preferences on a card or key flock/fob.

#### ***Allowable Subject Matter***

5. Claims 3, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As per Claims 3, 19:

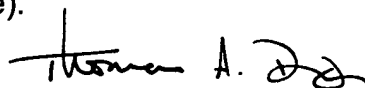
Walter (824) further discloses the method, wherein the payment instrument includes a check, see paragraph (0025), but does not disclose the privacy preference is printed onto the check.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Primary Examiner  
Art Unit 3639